

### **Remarks**

Claims 1-8 and 32-43 are pending in this application. Claims 2-4 are amended to correct typographical errors. Pursuant to a restriction requirement, claims 9-31 and 44-73 are canceled without prejudice to Applicants' right to pursue the subject matter recited by them in one or more divisional, continuation or continuation-in-part applications. No new matter has been introduced.

#### **A. The Rejection Under 35 U.S.C. § 102 Should Be Withdrawn**

On pages 2-3 of the Office Action, claims 1-2, 4-8, 32-39 and 42-43 are rejected under 35 U.S.C. § 102, as allegedly anticipated by Jeffery *et al.*, *J. Chem. Soc., Perkin Trans.*, 1: 2583-9 (1996) ("Jeffery"). In particular, it is alleged that these claims are anticipated by the structures 4 and 5a disclosed on page 2583 of Jeffery. Applicants respectfully traverse this rejection.

Claim 1 recites a genus of compounds, which are not racemic when: R<sub>1</sub>, R<sub>2</sub>, R<sub>4</sub> and R<sub>5</sub> are hydrogen and R<sub>3</sub> is hydroxyl, or when R<sub>1</sub>-R<sub>4</sub> are hydrogen and R<sub>5</sub> is hydroxyl. Claims 2 and 4-8 similarly recite that when R<sub>1</sub> and R<sub>2</sub> are hydrogen, the compound is not racemic. Claims 32-39 and 42-43 recite pharmaceutical compositions comprising compounds of claim 1.

None of the claimed compounds or pharmaceutical compositions are disclosed by Jeffery. For example, structures 4 and 5a are structures of racemic compounds.<sup>1</sup> Therefore, Applicants respectfully request that the rejection of claims 1-2, 4-8, 32-39 and 42-43 under 35 U.S.C. § 102 be withdrawn.

#### **B. The Rejection Under 35 U.S.C. § 103 (a) Should Be Withdrawn**

On pages 3-4 of the Office Action, claims 1-8 and 32-43 are rejected under 35 U.S.C. § 103(a) as being allegedly obvious over Jeffery. In particular, it is alleged that the compounds disclosed in Jeffery are "structurally so similar" to the claimed compounds, a reasonable expectation of achieving a successful composition would have existed, absent evidence to the contrary. Office Action, page 4. Applicants respectfully traverse this rejection.

---

<sup>1</sup> Applicants note that structures 5a and 5b depict cis/trans isomerization; they do not depict specific enantiomers of a compound.

Three criteria must be met to establish a *prima facie* case of obviousness: 1) the prior art references must teach or suggest all the claim limitations; 2) there must be some suggestion or motivation to modify or combine the cited references; and 3) there must have been, at the time of the invention, a reasonable expectation of success. Manual of Patent Examining Procedure, § 2143.

First, as discussed above, Applicants respectfully submit that Jeffery fails to meet each and every limitation of the pending claims. For this reason alone, Applicants request that the rejection of the claims under 35 U.S.C. § 103 be withdrawn.

Furthermore, Applicants respectfully submit that Jeffery would not have provided those of ordinary skill in the art with a motivation to make and use compounds of structures 4 and 5a, among others. This is because Jeffery reports that the pharmacological activity of sibutramine is “mediated *predominantly* by” two demethylated amines of sibutramine (compounds 2 and 3), implying that compounds 4 and 5a contribute little to sibutramine’s pharmacological activity. Jeffery, page 2583, left column (emphasis added). In this regard, Jeffery actually discourages those of ordinary skill in the art from obtaining compounds 4 and 5a in non-racemic form. For this and other reasons, Applicants respectfully request that the rejection of the claims under 35 U.S.C. § 103 be withdrawn.

### Conclusion

For the foregoing reasons, Applicants respectfully submit that all of the pending claims are allowable, and request that rejections directed to the claims be withdrawn.

No fee is believed due for this submission. Should any additional fees be due for this submission or to avoid abandonment of the application, please charge such fees to Jones Day Deposit Account No. 503013.

Respectfully submitted,

Date April 12, 2004

 45,479  
Max Bachrach (Reg. No.)  
**Jones Day**  
51 Louisiana Avenue, N.W.  
Washington, DC 20001-2113  
(202) 879-3939

For: Anthony M. Insogna (Reg. No. 35,203)  
**Jones Day**  
12750 High Bluff Drive Suite 300  
San Diego, CA 92130  
(858) 314-1200